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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,401	08/25/2000	Akiko Horiguchi	H&A-100	4524

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/645,401	HORIGUCHI ET AL.	
	Examiner	Art Unit	
	Pramila Parthasarathy	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's request for continued examination filled on March 14, 2005, has been fully considered but they are no new issues. After final response appear to amend the Claim 19 as currently amended. However, nothing was changed. Applicant has **not** filed amended claims. Accordingly, rejection of Claims 15 – 22 is maintained.

Information Disclosure Statement

2. An initialed and dated copy of Applicant's IDS form 1449 filled on 3/14/2005, is attached to the Office action.

3. Examiner requests the applicant to review the advisory action mailed on February 07, 2005. Examiner also provides a copy of the Advisory action in this office action.

Copy of Advisory Action

This office action is in response to the after-final request for reconsideration filed on January 14, 2005. In this response, applicant indicated that Claim 19 is currently amended, however Claim 19 is the same as it was presented in the amendment filed on 07/01/04. Thus, this response does not include any amended claims. Applicant's request for consideration has been fully considered but they are not persuasive because of the following reasons:

Regarding independent claims 15 and 19, applicant argued that the cited prior art (CPA) [Doggett U.S. Patent Number 5,677,955, hereinafter "Doggett"] does not contain all limitations.

Applicant argues that Doggett et al clearly do not disclose the presently claimed combination of providing an electronic tag having first information and also printing second information and a digital signature on the surface of the certificate.

Doggett describes the apparatus for issuing certificate to provide a trusted identification and generating digital signature with stored first information (unique user information) and second information (user public key) wherein the certificate is appended with a digital signature (Column 14 line 4 – 39). Doggett further describes a certificate paper-accommodating part wherein the certificate details the user information (Column 13 line 61 – Column 14 line 64) and prints a second information and a digital signature on the surface of the certificates (Column 19 line 66 – Column 20 line 21) and the digital signature is generated from the first information and the second information (Column 18 line 51 – Column 19 line 21). Doggett also shows the obvious advantage of providing the above said combination of features to make it possible to prevent counterfeiting the certificate by showing that the user of such certificate is provided with additional protection through private signature key (Column 21 lines 3 – 29).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15 – 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Doggett et al (U.S. Patent Number 5,677,955).

5. Regarding Claim 15, Doggett teaches and describes a certificate comprising:
an electronic tag attached on or put in the certificate and storing a first
information (Fig. 3, 17A,B; summary; Column 10 lines – 22 and Column 14 line 4 –
Column 15 line 32);

wherein a second information and a digital signature are printed on the surface of
the certificate (Fig. 3, 17A,B; summary; Column 10 lines – 22 and Column 14 line 4 –
Column 15 line 32); and

the digital signature is generated from the first information and the second
information (summary; Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line
6).

6. Regarding Claim 19, Doggett teaches and describes a certificate comprising: an apparatus for issuing a certificate comprising:

a certificate paper-accommodating part which certificates comprising electric tags which accommodates stores first information (Fig. 3, 17A,B; summary; Column 10 lines – 22 and Column 14 line 4 – Column 15 line 32);

a printing part which prints a second information and a digital signature on the surface of the certificates Fig. 3, 17A,B; summary; Column 10 lines – 22 and Column 14 line 4 – Column 15 line 32); and

wherein the digital signature is generated from the first information and the second information (summary; Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line 6).

7. Claims 16 and 20 are rejected as applied above in rejecting claims 15 and 19. Furthermore, Doggett teaches and describes a certificate wherein the digital signature is generated from a linkage or a hashed linkage of the first information and the

second information using RSA (Summary; Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line 6).

8. Claims 17 and 21 are rejected as applied above in rejecting claims 15 and 19. Furthermore, Doggett teaches and describes a certificate wherein the digital signature is a sum or a hashed sum of the first information and the second information using RSA (Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line 6).

9. Claims 18 and 22 are rejected as applied above in rejecting claims 15 and 19.

Furthermore, Doggett teaches and describes a certificate wherein the first information is represented by x_1 , the second information is represented by x_2 and the digital signature is represented by y , secret keys are represented by d and n , and the digital signature is obtained by the equation $y = (x_1 + x_2)^d \bmod n$, where the function represents linking of x_1 and x_2 to each other (Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line 6).

Conclusion

10. This is a request for continued examination of applicant's earlier Application No. 09/645,401. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on Tuesday – Thursday 8:00a.m. To 3:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy
March 26, 2005.


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100